

# Notice of Allowability

Application No.

09/717,448

Examiner

Rob Rhode

Applicant(s)

MCINTYRE ET AL.

Art Unit

3625

*My*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment of 10/4/2004 and Amendment of 11/17/2004.
2. ☒ The allowed claim(s) is/are 1-8.
3. ☒ The drawings filed on 04 October 2004 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date 11/17/2004.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

*Jeffrey A. Smith*  
Jeffrey A. Smith  
Primary Examiner

### **Response to Amendment**

Response, amendment faxed, received on 11-18-04 is acknowledged and entered.  
Currently, claims 1 – 8 have been examined and claims 9 – 17 have been canceled.

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Puncelli on November 17, 2004.

The application has been amended as follows:

### **In the Claims**

Claims 1 - 8 have been rewritten as follows:

1. (previously amended) A method of providing image goods and/or services to more than one party located at different locations, comprising the steps of:

capturing substantially simultaneously ~~capturing~~ an image both electronically and on a photosensitive media by a customer using a camera;

transmitting via a computer network said electronic image to a third party at a location remote from said customer along with additional data, said additional data identifying said image with respect to said photosensitive media;

placing an order via a computer network by said customer and/or said third party ~~having the ability for placing an order with~~ a service provider for at least one good and/or service with respect to said image on said associated photosensitive media associated using said electronic image prior to said service provider receiving said photosensitive media; and

assembling by said service provider ~~assembling the~~ said order upon receipt of the photosensitive media.

2. (original) A method according to claim 1 wherein said additional data comprises a database location at which said order may be electronically accessed by said service provider for determining if additional orders exist with respect to said images.

3. (original) A method according to claim 1 wherein said customer advises said service provider that said image has been forwarded to said third party for potential placement of an order with respect to said image.

4. (original) A method according to claim 3 wherein said customer forwards to said service provider the e-mail address of said third party to which said digital image has been forwarded.

5. (original) A method according to claim 4 wherein said service provider forwards electronically to said customer and said third party confirmation that said order has been received.

6. (original) A method according to claim 1 wherein said customer provides a predetermined amount of credit which may be charged to said customer with respect to the ordering of goods and/or services by said third party.

7. (original) A method according to claim 1 wherein said information forwarded to said third party further includes a computer software program whereby the order can be automatically forwarded to said service provider by said third party by selecting from pre-designated options provided in addition to said images.

8. (currently amended) A method of providing image goods from a service provider and/or services to a plurality of customers located at different locations, comprising;  
capturing substantially simultaneously ~~capturing~~ an image both electronically and on a photosensitive media by a customer using a camera, said electronic image

comprising a predetermined image resolution, said camera having a selection switch that results in the creation of identifying data that identifies that digital images are or have been forwarded to a third party for ordering of goods and/or services made using said photosensitive media;

forwarding via a computer network said identifying data to said service provider prior to execution of providing goods and/or services with respect to images on said photosensitive media.

transmitting via a computer network said electronic images to said third party along with said identifying data with respect to said images transmitted; and

~~said third party~~ placing an order by said third party for goods and/or services with respect to said images on said photosensitive media using said identifying data and said digital images from which the order may be placed.

By virtue of the above Examiner's Amendment claims 1 - 8 are pending for examination and are allowed.

### **Reasons for Allowance**

The following is an examiner's statement of reasons for allowance and the statement of allowance is with reference to independent claims 1 and 8. Claims 3 - 7 are dependencies of claim 1.

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The Applicant's invention in claims 1 and 8 are directed to a novel and non-obvious method capturing an image with a hybrid camera substantially simultaneously and the camera having a selection switch that results in the creation of identifying data that identifies that digital images are or have been forwarded to a third party for ordering of goods and/or services made using said photosensitive media and forwarding identifying data to a service provided prior to execution of providing goods and/or services with respect to images on the photosensitive media. The invention claimed in independent claims 1 and 8 are distinguished from prior art of record by the fact that a method of providing image goods and/or service to more than one party comprising, **transmitting via a computer network said electronic image to a third party at a location remote from said customer along with additional data, said additional data identifying said image with respect to said photosensitive media; and placing an order via a computer network by said customer and/or said third party with a service provider for at least one good and/or service with respect to said image on said associated photosensitive media associated using said electronic image prior to said service provider receiving said photosensitive media.**

Discussion of the most relevant prior art, which does not disclose the invention as stated in claims 1 and 8:

**A. US Patents and PG-Pubs.**

(i) US Patent US 6,578,072 to Watanabe discloses a network photographic service, which provides digital photographic services on a network. The digital images and/or film are forwarded by a customer to a service provider for storage in an image database and that they wish to share with others. The forwarded images are part of an order by the customer for establishing an album consisting of the sent images and/or film, which is developed and uploaded to the database. In turn, the customer as well as third parties, who are provided access can review the images and order appropriate images, which are then developed by the service provider. Watanabe does not teach forwarding the identified images to a third party for their review and selection before an order by the customer or the third party is placed with service provider and prior to the service provider receiving the film. This online method disclosed by Watanabe fails to anticipate the above bolded unique limitations or render them obvious.

(ii) US 6,657,702 B1 to Chui discloses a method to facilitate print re-ordering by encoding a photographic print with an identifier of the recipient as well as any printing parameters. The method further discloses an individual placing an order for themselves as well as others. Chi does not teach forwarding the identified images to a third party for their review and selection before an order by the customer or the third party is placed with service provider and prior to the service provider receiving the film. This online

method disclosed by Chi fails to anticipate the above bolded unique limitations or render them obvious.

(iii) US 6,321,231 B1 to Jebens discloses a digital data management and order delivery system is provided. The method includes a storage device for storing digital data and a searching engine for developing a subset of the digital data stored in the storage device in response to inputs received from a first user. The method is also provided with a job order developer responsive to inputs received from the first user for developing a job order which includes: a) at least one copy of the digital data contained in the subset and identified by the first user; and b) a file containing information developed by the first user outside the method. Jebens does not teach forwarding the identified images to a third party for their review and selection before an order by the customer or the third party is placed with service provider and prior to the service provider receiving the film. This online method disclosed by Jebens fails to anticipate the above bolded unique limitations or render them obvious.

(iv) US 6,715,003 B1 to Safai discloses a photo service provider with remote developing, printing and delivery of photographic prints. The images and/or film can be sent directly to the service provider as part of the order. Additionally, the customer can also obtain a service for selected images to be forwarded to specific recipients. In turn, these third parties can provide orders for selected prints with the service provider. Thereby, Safai does not teach forwarding the identified images to a third party for their

review and selection before an order by the customer or the third party is placed with service provider and prior to the service provider receiving the film. This online method disclosed by Jebens fails to anticipate the above bolded unique limitations or render them obvious.

### **B. Non Patent Littérature**

(v) "dotphoto" screen shots captured via the WayBackMachine and dated 8/15/2000 discloses a method for customers to send their images to this service provider for uploading into their own account and enabling others to access and order images and prints of interest. Additionally, the service provided includes the ability for the customer to forward film and have the film developed and uploaded for review and ordering. Dotphoto does not teach forwarding the identified images to a third party for their review and selection before an order by the customer or the third party is placed with service provider and prior to the service provider receiving the film. This online method disclosed by dotphoto fails to anticipate the above bolded unique limitations or render them obvious.

### **C. Foreign Patent Literature**

(vi) Mitsubishi (JP 09259189A) discloses a method with a system scanner provided to customer, which allows them to scan in the book and upload to service provider such as publisher. Mitsubishi does not teach forwarding the identified images

to a third party for their review and selection before an order by the customer or the third party is placed with service provider and prior to the service provider receiving the film. This online method disclosed by Mitsubishi fails to anticipate the above bolded unique limitations or render them obvious.

### **Conclusion**

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is (703) 305-8230. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

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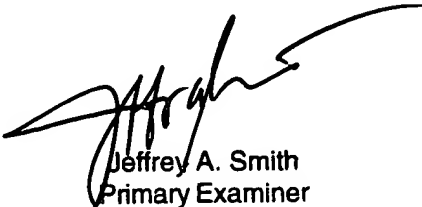
or faxed to:

(703) 872-9306 [Official communications; including  
After Final communications labeled  
"Box AF"]

(703) 746-7418 [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RER



Jeffrey A. Smith  
Primary Examiner